

Remarks

Status of the claims

Claims 1, 34, and 46 have been amended to clarify that when certain moieties form an optionally substituted ring as in part (b) of a definition, those moieties are not also selected as in part (a) of the same definition. Claims 1, 34, and 46 have also been amended to delete recitation of “-N⁺(R⁷⁷)₃.”

Claims 1 and 34 have been amended to remove recitation of “R⁸” in the phrase “each of R¹, R², R³, R⁴, R⁵, R⁶, R⁷, R⁹, R¹⁰, R¹¹, R¹², R¹³, R¹⁴, R¹⁵, R¹⁶, R¹⁷, R¹⁸, R¹⁹, R²⁰, R²¹, R²², R²³, and R²⁴ and R³⁰, R³¹, R³², R³³, R³⁴, R³⁵ and R³⁶.”

Claims 13, 22, 28, and 42 have been amended to correct an obvious typographical error in the formula “-C(O)NHCH(CH₃)(CH₂CH₃),” in which the valence of the nitrogen atom was incorrect because it was missing an adjoining hydrogen atom.

Claims 7 and 34 have been amended to delete the phrase “esters, enol ethers, enol esters, acetals, ketals, orthoesters, hemiacetals, hemiketals, acids, and bases, thereof.”

Claim 42 has also been amended to replace a period at the end of the definition of R⁶ and R⁷ with a semicolon.

In addition, claim 46 has been amended to replace a period at the end of the definition of R⁴, R⁵, R⁶, and R⁷ with a semicolon, and to replace the phrase “R¹-R²⁴ and R³⁰-R³⁶,” with the phrase “R¹, R², R³, R⁴, R⁵, R⁶, R⁷, R⁹, R¹⁰, R¹¹, R¹², R¹³, R¹⁴, R¹⁵, R¹⁶, R¹⁷, R¹⁸, R¹⁹, R²⁰, R²¹, R²², R²³, and R²⁴ and R³⁰, R³¹, R³², R³³, R³⁴, R³⁵ and R³⁶.”

None of the amendments constitute new matter.

With these amendments, claims 1-46 and 48 are pending consideration.

Elections/Restrictions

The Office asserted on page 2 of the pending Office Action that “Applicants’ traversal of claims 6-31 as being withdrawn from further consideration...is herein moot, the Election filed February 5, 2010 was treated as an election without traverse.” Applicants disagree.

While the Applicants agree that the Election filed February 5, 2010 was made without traverse, the Applicants are not arguing that the restriction requirement was improper; thus, whether or not the election was made with or without traverse is immaterial to this matter.

Rather, Applicants respectfully submit that the Office's withdrawal of claims 6-31 from consideration is not proper under the procedure for examining Markush claims set forth in MPEP § 803.02, which states:

A Markush-type claim may include independent and distinct inventions. ... In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits. ... Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.

On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration.

(Emphasis added.) The Applicants submit that, according to MPEP § 803.02, a search of a Markush claim (*which may include independent and distinct inventions*) is to begin with the elected species and, if the species is allowable over the prior art, expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope of the claims only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution, which requires simultaneous examination of the claims as to all bases of patentability.

Because the Office has not rejected any of the claims as “anticipated or rendered obvious by prior art,” the Office is not entitled, at this time, to withdraw claims 6-31 from consideration. Accordingly, Applicants respectfully submit that the subject matter of claims 6-31 must be searched and examined pursuant to MPEP § 803.02.

The applicants are simultaneously submitting herewith a petition to the technology center Director for withdrawal of the finality of this action.

Improper finality of Office Action

Applicants respectfully submit that the finality of the pending Office Action is improper. As discussed above, no prior art has been found that anticipates or renders obvious the elected species (rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species); thus, the Office was required to extend the search and examination of the application to the full scope of the claims, as set forth under MPEP § 803.02.

Because the Office has not completed the procedures set forth in MPEP § 803.02 for examining Markush claims, Applicants submit that the Office has closed prosecution prematurely. Accordingly, Applicants respectfully request that the finality of the pending Action be withdrawn.

Rejections under 35 USC § 112, ¶ 2, definiteness

In paragraph 5 of the pending Action, the Office has maintained various rejections under 35 USC § 112, second paragraph, to which the Applicants respond:

In parts (a) and (o) of paragraph 5, claims 1 and 46, respectively, and those dependent thereon were rejected for lack of antecedent basis for the recitation of R³³ and R³⁴. Merely in order to expedite prosecution, the Applicants have amended claims 1 and 46 to clarify that when R³³ and R³⁴ are taken together to form a ring as in part (b) of the definition, they are not “selected as in part (a).” These amendments do not change the scope of the claims but merely rephrase the claims in an equivalent manner.

In parts (c), (h), and (q) of paragraph 5, claims 1, 34, and 46, respectively, and claims dependent thereon were rejected for lack of antecedent basis for the recitation of R¹⁵ and R¹⁶. Merely in order to expedite prosecution, the Applicants have amended claims 1, 34, and 46 to clarify that when R¹⁵ and R¹⁶ are taken together to form a ring as in part (b) of the definition, they are not “selected as in part (a).” These amendments do not change the scope of the claims but merely rephrase the claims in an equivalent manner.

In parts (d), (i), and (r) of paragraph 5, claims 1, 34, and 46, respectively, and claims dependent thereon were rejected for lack of antecedent basis for the recitation of R²¹ and R²². Merely in order to expedite prosecution, the Applicants have amended claims 1, 34, and 46 to

clarify that when R^{21} and R^{22} are taken together to form a ring as in part (b) of the definition, they are not “selected as in part (a).” These amendments do not change the scope of the claims but merely rephrase the claims in an equivalent manner.

In parts (f), (k), and (t), claims 1, 34 and 46, respectively, and claims dependent thereon were rejected because it was alleged that the meaning of $-N^+(R^{77})_3$ in the definitions of Q^1 and Q^2 is unclear as “there is no counterion indicated and a ‘compound’ is not an ion.” Applicants disagree, but have deleted “ $-N^+(R^{77})_3$ ” from claims 1, 34, and 46 merely in an effort to expedite prosecution.

In part (p), claim 46 and claims dependent thereon were rejected for the recitation of a period at the end of the definition of R^4 , R^5 , R^6 , and R^7 . Claim 46 has herein been amended to replace the period with a semicolon.

In part (s), claim 46 and claims dependent thereon were rejected for the recitation of “ R^1 - R^{24} ” and “ R^{30} - R^{36} ”. While the Applicants respectfully disagree, claim 46 has been amended to recite each of R^1 through R^{24} and R^{30} through R^{36} , except for R^8 , which is not recited anywhere in claim 46, thereby obviating this rejection. These amendments do not change the scope of the claims but merely rephrase the claims in an equivalent manner.

Rejections under 35 USC § 112, ¶ 1, enablement

The Office has rejected claims 34-42, 44, and 48 as lacking enablement for “esters, enol ethers, enol esters, acetals, ketals, orthoesters, hemiacetals, hemiketals, acids and bases thereof,” though concedes that the claims are enabled for pharmaceutically acceptable salts thereof. Applicants disagree, but, merely in an effort to expedite prosecution, have deleted the phrase “esters, enol ethers, enol esters, acetals, ketals, orthoesters, hemiacetals, hemiketals, acids and bases” from the claims. Accordingly, applicants respectfully request reconsideration and withdrawal of the rejections of claims 34-42, 44, and 48 under 35 USC § 112, first paragraph (enablement).

Rejections under 35 USC § 112, ¶ 2, indefiniteness

The Office has rejected claims 1 and 34, and claims dependent thereon, as vague and indefinite for recitation of the moiety R^8 . Claims 1 and 34 have herein been amended to remove recitation of R^8 .

The Office has rejected claim 42 as vague and indefinite for recitation of a period at the end of the definition of R⁶ and R⁷. Claim 42 has herein been amended to replace the period with a semicolon.

Claim Objections

The Office has objected to claim 42 because the moiety “-C(O)NCH(CH₃)(CH₂CH₃)” is missing a valency on the nitrogen atom. Claim 42 has been amended herein to correct the typographical error in the moiety by adding an adjoining hydrogen atom to the nitrogen atom, thereby correcting the valency of the nitrogen atom. Claims 13, 22, and 28, which recite the same moiety, have been amended likewise.

The Office has objected to claims 43 and 45 as dependent upon a rejected base claim. Applicants submit that independent claim 34, on which claims 43 and 45 depend, as amended, is currently in allowable form.

The Office has objected to claims 1, 32, 33, 34, 46, and claims dependent thereon, as well as claims 6-31 as drawn to an invention nonelected without traverse, and asserts that a complete reply to the final rejection must include cancellation of nonelected claims. Applicants respectfully submit that, as set forth above, the finality of the Action was improper; thus, cancellation of the nonelected claims or subject matter is not required at this time.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the claim objections.

The Applicants respectfully submit that the foregoing arguments and amendments overcome all pending rejections; furthermore, pursuant to MPEP § 803.02, the Applicants are entitled to a search of the full scope of the claims permitted by the prior art (irrespective of any issues under 35 USC § 112). If art is found rendering the claims unpatentable under 35 USC § 102 or 103, the next Office Action cannot be made final because the Applicants were entitled to such a search before the first Office Action.

If it is believed that a teleconference will advance prosecution, the examiner is encouraged to contact the undersigned as indicated below.

Respectfully submitted,

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